

**REMARKS**

Upon entry of this amendment, claims 1-7 and 10-16 are pending in application. Claims 8 and 9 have been canceled without waiver of the right to file divisional or continuation applications directed to the same or similar subject matter.

Claims 1-7 were rejected under 35 U.S.C. §112, ¶2 due to lack of antecedent basis for terms appearing in claim 1. Claim 1 has been amended to cure the perceived deficiencies. The specification was objected to for lack of an Abstract. An Abstract on a separate sheet is attached hereto.

Claims 1-7 were rejected under 35 U.S.C. §103(a) as unpatentable over Ballestrazzi et al., U.S. Patent No. 4,338,768 in view of Irvine, U.S. Patent No. 5,052,977 and Roou, U.S. Patent No. 4,841,712.

Applicant respectfully traverses the rejection. Independent claims 1 and 10 are directed to a process that alleviates some of the problems associated with sorting mass mailings received as bundles of individually wrapped items. Bundled of separate, individually wrapped items are difficult to process with known sorting machine feeder technology due to adhesion of the individual items to each other and to the feeder. (*See*, Specification, p. 1, lines 9-24). Damage to the individual items often results. *Id.* Further, the process of breaking open the bundles, properly positioning and the stacking the unbundled mail pieces on a sorter feeder, and monitoring the operation of the feeder is labor intensive. *Id.*

The currently claimed method addresses these problems by shrink-wrapping the individual mailings of a mass mailing to form a strip of film bags, each containing a mailing. The strip of film bags is transported to a respective destination where the strip of bags is threaded into the material input of a sorting machine. The bags are separated, and then accelerated to produce gaps between the bags required to process the individual bags with the sorting machine. In this manner, the method of the invention eliminates the need to break open bundles of individually packaged mailings, stack the mailing on a sorter feeder and monitor the feeding operation for jams resulting from the individual items sticking to each other or to the feeder surfaces.

The process disclosed in the Ballestrazzi reference does not address the difficulties encountered when sorting a mass mailing consisting of individual or individually wrapped mail

items. Rather, Ballestrazzi discloses wrapping items, for example magazines, in a polyethylene film and sealing and cutting the film between one item and the next in a single operation on a single machine. (*See*, col. 3, lines 37-47, Figure 1). In the same process and on the same machine that wraps the items, the separated items are sent to a stacker which stacks the items in batches. *Id.*

As noted in the Office Action, Ballestrazzi does not disclose shrink wrapping a mailing between strips of film wherein the strip of bags is hanging together at the destination and wherein the strip of bags is threaded into a sorting machine before being separated into individual bags. Ballestrazzi also does not disclose or suggest dispatching a mass mailing from a sender to a sorting destination as a continuous strip of bags. Fairly read, Ballestrazzi thus teaches away from the invention as presently claimed. MPEP §2145(X)(D)(2) ("It is improper to combine references where the references teach away from their combination.").

The Roou reference does not cure these deficiencies. Roou, cited for disclosing wrapping items between strips of film, is directed to creating and packaging premium items such as coupons or sports cards. (col. 3, lines 14-65, col. 4, lines 5-10). The process is (including separating the items) conducted on a single machine. (*See*, col. 2, lines 61-68). The premium items of Roou are not a mass mailing consisting of individual mailings requiring sorting. Further, there is no suggestion or teaching that the process of Roou would be applicable to mass mailing to be sorted at a destination.

The Office Action suggested that one would have been motivated to combine Roou with Ballestrazzi to avoid sealing lines to provide a clear view of the item being wrapped. However, neither Roou nor Ballestrazzi identify sealing lines as a problem. Common sense would dictate that the welding or adhesion of film to form a package around an item would be done around the periphery of the item, not over the item. Nor does the Office Action explain how or why any item would ever be ever be shrink-wrapped in a manner that would create sealing lines over the item, rather than around the perimeter of the item. Consequently, the suggested motivation for the combination appears to be a solution looking for a problem rather than a proper basis for combining the references. MPEP §2143.01(I). ("Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in

the references themselves or in the knowledge generally available to one of ordinary skill in the art.”).

Likewise Irvine does not cure the deficiencies of the Roou nor Ballestrazzi, taken alone or in combination. Irvine discloses a multiple web business form stock for forming mailers. (col. 1, lines 7). The form stock is not a mailing, rather, the customer (sender) feeds the stock through a printer to provide personalized printing and passes the stock through a plow folder to fold. (col. 6, lines 13-21). The stock is then passed through a trimmer and a burster where it is separated into individual mailers. *Id.* The form stock may be shipped in a folded form (Figure 7).

The business stock of Irvine is not a mass mailing consisting of individual mailings. Nor does the business stock of Irvine include a string of film bags, each containing an individual mailing. Further, once a customer (sender) has printed the business stock of Irvine to create mailers, the customer then separates the stock into individual mailers. (col. 6, lines 15-19). At no time does Irvine suggest packaging a mass mailing in film bags and then transporting the unseparated bags to a destination for separating and sorting.

Nor does the Office Action identify any suggestion or motivation for combining Irvine with Roou and/or Ballestrazzi other than to conclude that the combination is obvious. Absent such suggestion or motivation, Applicant submits that the combination is no more than hindsight reconstruction. MPEP §2143.01(III)(“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”).

In view of the foregoing, Applicant respectfully submits that independent claims 1 and 10 along with dependent claims 2-7 and 11-16 are allowable over the cited references.

Applicants have made an earnest effort to place the application in condition for allowance. Favorable action and passage of the case to issue are respectfully requested.

It is believed that no additional fee is due. If this is incorrect, the Commissioner is hereby

authorized to charge any fees which may be required by this paper to Deposit Account No. 50-1588.

Respectfully submitted,



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